

REMARKS/ARGUMENTS

Claims 1-7 are pending in the present application. Claims 1 and 2 have been withdrawn. Claim 3 has been rejected under 35 U.S.C. 102(b) as being anticipated by Moon et al. (U.S. Pat. No. 3,585,901). Claims 4-6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. in view of Wilkosz et al (U.S. Pat. No. 5,655,432). Claim 7 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Moon. Applicant respectfully traverses all rejections.

Claim 3 has been rejected under 35 U.S.C. 102(b) as being anticipated by Moon. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and

that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 3 has been amended to require the step of "forming a cylinder block having a center cylindrical bore, uniformly spaced radially located cylindrical bores having a smaller diameter than the center cylinder bore, and a lip that extends into and mates with the flange of the base plate." The Moon reference does not teach a cylinder block having a lip that extends into and mates with the flange of a base plate. Instead, Moon teaches a hardened port plate 51 that is pinned to the cylinder block at 51A and is carried by the cylinder block under the urging of spring 43 into slidable contact with valve plate 52 which is pinned at 52A to end plate 11. (Col. 4, lines 68-72). Thus, the cylinder block does not have a lip that extends into and mates with a flange of a base plate. Therefore, each and every limitation of the claimed invention is not present and the anticipation rejection must be withdrawn.

Dependant claims 4-6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Moon et al. in view of Wilkosz. Applicant asserts that the apparatus that would result from the combination of Moon and Wilkosz would not meet

all of the limitations of claims 4-6. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Specifically, the claimed combination would not teach "a lip that extends into and mates with the flange of a base plate". The Moon reference, as discussed above, does not teach this requirement. Similarly, Wilkosz does not teach a lip that extends into and mates with the flange of a base plate, and instead teaches a two-piece cylinder block wherein each piece has a plurality of grooves. (Col. 2, lines 62-66 and see Fig. 1). Thus, the proposed combined device would not have each and every limitation of the claimed invention and therefore, the obviousness rejection must be withdrawn.

Further, dependent claim 4 requires a cylinder block wherein "the base plate is formed by near net shaping technologies comprising one of powdered metal, forging, stamping, lost foam, or extrusion." As admitted by the Examiner, Moon does not teach the manufacturing method of the cylinder block within Moon. Likewise, Wilkosz does not teach a cylinder block wherein the base plate is formed by near net

shaping technologies but instead teaches a swashplate 20 that is manufactured by a forging process and is made into a near net shape. (Col. 4, lines 15-16). Thus, the claimed combination would not provide a method of making a cylinder block wherein the base plate is formed by near net shaping technologies. Therefore, each and every limitation of the claimed method is not present and the obviousness rejection must be withdrawn.

Dependent claim 5 requires the method of claim 4 wherein "the cylinder block is formed by near net shaping technologies." Wilkosz does not teach forming the cylinder block with near net shaping technologies and instead teaches forming a swashplate 20 with near net shaping technologies. Thus, the claimed limitation is not met and the obviousness rejection must be withdrawn. Additionally, claim 6 depends on claims 3 and 4 and claim 7 depends on claim 3, and for at least these reasons, are also considered in allowable form.

CONCLUSION

In view of the above remarks, Applicant believes that claims 3-7 are in condition for allowance and Applicant respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however,

consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account 50-
2098.

Respectfully submitted,



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